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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,192	09/17/1999	JOHN WANKMUELLER	AP31994-0704	1972
7590 04/22/2009 BAKER & BOTTS LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10110228				
EXAMINER AGWUMEZIE, CHARLES C				
ART UNIT 3685		PAPER NUMBER		
MAIL DATE 04/22/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/399,192

Applicant(s)

WANKMUELLER ET AL.

Examiner

CHARLES C. AGWUMEZIE

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-13, 17, 19-29, 33, 35-45, 49 and 50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1, 3-13, 17, 19-29, 33, 35-45, 49 and 50 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 24, 2009 has been entered.

Acknowledgment

2. Applicant's amendment filed on February 24, 2009 is acknowledged. Accordingly claims 1-13, 17-29, 33-45, 49 and 50 remain pending and have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 20, 21 and 33-45** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is directed to an apparatus. However, the claim also recites method steps (e.g. "... cause the processor to perform the steps of..."). It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2 (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). Therefore, claim 33 is rejected at least as it does not sufficiently provide an accurate determination of the 'metes and bounds' of the Applicant's apparatus (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Claims 20, 25 (i.e. wherein the cryptographic operation uses...) and 34-45 are also rejected as each recites language similar to claim 33.

Claims 21 and 34-45 are also rejected as each depends from either claim 29 or 33.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13, 17-29, 33-45, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. Patent No. 6,163,771 in view of Hamilton U.S. Patent No. 5,175,766.

7. As per claims 1-13, 17-29, 33-45, 49 and 50, Walker et al. teach a method for generating identification data comprising:

- storing a first numerical code (i.e. credit card number/account number) (figure 5, item 501, figure 13; column 7, lines 45-48 and lines 60-61; column 8, lines 20-25; column 11, lines 25-40)
- generating a second numerical code on a central computer by performing a cryptographic operation (e.g. addition or subtraction) (column 8, lines 19-25) on the first numerical code (figure 13; column 11, lines 25-40) and cryptographically computed data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40)
- storing a conversion key and using the conversion key to perform the cryptographic operation on the first code (column 8, lines 16-25)
- deriving the conversion key by cryptographically (e.g. DES) (column 9, lines 10-20; column 10, lines 5-10) applying a (secret) deriving key to conversion key (initial) data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40)
- generating cryptographically computed data (column 7, lines 62-64; column 8, lines 13-17; column 11, lines 25-40) wherein the data has

the same base (e.g. 2 or 10) as the first numerical code (figure 5, item 501)

- What Walker failed to explicitly disclose is:
- receiving said customer account number and said non-ATM electronic commerce PIN during an electronic commerce transaction conducted over a network, wherein said electronic commerce transaction is a non-ATM financial transaction;
- performing a second cryptographic operation on said non-ATM electronic commerce PIN using at least said conversion key; comparing the result of the second cryptographic operation to said ATM PIN; and authorizing said electronic commerce transaction.
- Hamilton discloses a method for authorizing transaction, comprising:
- receiving said customer account number and said non-ATM electronic commerce PIN during an electronic commerce transaction conducted over a network, wherein said electronic commerce transaction is a non-ATM financial transaction (col. 16, line 45- col. 17, line 25; col.18,lines 15-45)
- performing a second cryptographic operation on said non-ATM electronic commerce PIN using at least said conversion key (col. 2, line 60-col. 3, line10; col.18,lines 15-25); comparing the result of the second cryptographic operation to said ATM PIN (col. 18, lines 25-45); and

- authorizing said electronic commerce transaction (col. 18, lines 25-45)

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Walker and incorporate the method comprising receiving said customer account number and said non-ATM electronic commerce PIN during an electronic commerce transaction conducted over a network, wherein said electronic commerce transaction is a non-ATM financial transaction; performing a second cryptographic operation on said non-ATM electronic commerce PIN using at least said conversion key; comparing the result of the second cryptographic operation to said ATM PIN; and authorizing said electronic commerce transaction in view of the teachings of Hamilton et al in order to ensure adequate security.

8. As per claims 5 and 9-11, Applicant attempts to limit the claimed method by further describing the derivation data. However, it has been held that data stored in computer memory that is not functionally related to the memory will not differentiate a claimed method from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Hence, the composition of the claimed derivation data cannot be relied upon to distinguish the claimed from the teachings of Walker et al. (column 7, lines 62-64; column 8, lines 13-17).

9. As per claims 20-21, and 33, 35-45, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, how Applicant's apparatus is intended to perform will not differentiate the claims from the prior art.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Zingher et al. disclose PINs of N digits

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Calvin Hewitt** can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Examiner, Art Unit 3685
April 20, 2009